

SN. 10/658,690

ATTORNEY DOCKET NO. FUJI:278

IN THE DRAWINGS

Applicants submit formal Figs. 8A-10E with the legend "Prior Art" as required by the examiner.

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REMARKS

Claims 1-24 are now pending in this application for which applicants seek reconsideration.

Amendment

Corrected Formal Figs. 8A-10E now include the legend --Prior Art--.

Independent claims 1 and 16 have been amended to further define that the magnetic recording medium is rotationally alignable with the master disc using the alignment mark provided on the first or second side of the magnetic recording medium. New claims 21-24 that further define the alignment mark have been added.

Claim 16 further has been amended to improve its form by removing the language "one of" to avoid confusion. In *Superguide Corp. v. DirecTV Enterprises, Inc.*, 358 F.3d 870, 69 USPQ2d 1865 (Fed. Cir. 2004), the court stated that the proper conjunction in the alternative listing following the phrase "one of" or "at least one of" is "or" not "and."

No new matter has been introduced.

Art Rejection

Claims 1, 4, 9, 10, 13, 14, and 16 were rejected under 35 U.S.C. § 102(e) as anticipated by Matsuda (USP 6,721,113). Claims 2, 3, 5, 8, 11, 12, 15, and 17-20 were rejected under 35 U.S.C. § 103(a) unpatentable over Matsuda in view of Hamano (USPA 2002/0081018). Applicants traverse these rejections because neither of these references would have disclosed or taught the claimed alignment marks as set forth in claims 1 and 16.

Independent claims 1 and 16 both call for providing alignment marks on both sides of a magnetic recording medium. As claimed, there are at least two alignment marks on the medium. The examiner takes the position that the center hole in the recording medium corresponds to the claimed alignment marks. The examiner's position is that because Matsuda's center hole extends completely through the medium, the mark remains visible from both sides, thus providing two alignment marks. Applicants disagree with the examiner's interpretation of Matsuda. Nonetheless, claims 1 and 16 have been amended to further define that the alignment marks rotationally align the magnetic recording medium and the master disc. Because Matsuda's alleged alignment mark is formed at the center of the disc, it cannot rotationally align the magnetic recording medium relative to the master disc (or vice versa). New dependent claims further recite that the alignment marks are positioned off center or do not form throughholes.

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As to the rejection based on the combination of Matsuda and Hamano, the examiner asserts it would have been obvious for Matsuda to place the alignment marks outside the data area where the magnetic information on the magnetic recording medium is written or read. Applicants disagree with the examiner's assessment because there would not have been any motivation for Matsuda to use the alignment marks of the type taught by Hamano. Indeed, adopting Hamano's teaching would essentially eviscerate Matsuda's invention. Note that Matsuda aligns the magnetic recording medium with the master disc using an optical sensor 2 through a central opening in the magnetic recording medium. Placing alignment marks as urged by the examiner would require Matsuda to place many openings through the magnetic recording medium. Moreover, many optical sensors would be required. In short, one of ordinary skill in the art would not have been motivated to form additional markings in Matsuda's arrangement.

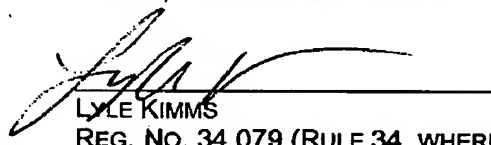
Conclusion

Applicants submit that claims 1-24 patentably distinguish over the applied references and are in condition for allowance. Should the examiner have any issues concerning this reply or any other outstanding issues remaining in this application, applicants urge the examiner to contact the undersigned to expedite prosecution.

Respectfully submitted,

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24 JULY 2005
DATE



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REG. NO. 34,079 (RULE 34, WHERE APPLICABLE)

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